

Applicant: Antti Heikkinen et al.
Application No.: 10/518,416
Response to Office action dated Aug. 27, 2007
Response filed November 27, 2007

Remarks

Claims 29–35, 43–54, and 56–58 remain pending in the application. Claims 43–54 and 56–58 stand withdrawn. In the Office action dated Aug. 27, 2007 claims 29–35 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Heikkinen* (WO 01/23666) in view of *Taylor* (5,065,673). Claims 29–35 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 31–44 of co-pending Application No. 10/598,664.

Claim 29 has been amended to overcome the indefiniteness rejection.

In the Office action dated Aug. 27, 2007, the examiner reasons “It would have been obvious to try to move the early moistening control to prior to the first calendaring of the web *since Taylor does not point out any unusual results by the present [i.e., Taylor’s] early moistening location.* [Emphasis added.]” The examiner’s reasoning admits a substantial difference between *Taylor* and applicant’s claimed invention, yet the examiner argues that *Taylor*’s failure to disclose unusual results, makes applicants claimed invention obvious.

The burden of showing nonobviousness starts with the examiner’s burden of making a prima facie case. If the case is made, applicant must rebut the case by argument or a showing of facts. The burden of showing nonobviousness is never shifted to the references, so that we can never say the reference has failed to prove nonobviousness, i.e. unusual results.

The first part of the examiner’s statement “*It would have been obvious to try*” does not logically lead to a prima facie case of obviousness. Almost all inventions are the result of experimentation. The examiner must provide a reasoned explanation for why the prior art would lead a person of ordinary skill in the art to the claimed invention without undue experimentation. The examiner must show some motivation within the prior art and some expectation of success, for doing what applicant has claimed. In general it may be obvious to try all things until you find something that works, but a prima facie case of obviousness of a particular claimed invention, requires a teaching within the prior art of the problem, and a teaching within the prior art of how to proceed without undue experimentation.

The examiner states that “*Heikkinen and Taylor* disclose the elements of the

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invention.” Almost all inventions are constructed from known elements or steps, but this says nothing about whether the prior art provides the suggestion and motivation for combining applicant’s claimed limitations.

The examiner states “One of ordinary skill in the art could have combined the elements by known methods....” This is an after the fact assessment, i.e. hindsight. It is of course assumed that if applicant has applied for a patent that the elements or steps can be combined as claims. But the test for obviousness is whether the prior art suggests the combination, by providing a motivation and expectation of success for applicant’s claimed invention, not whether a combination *could* be made. In the same sentence the examiner goes on “...the combination of *Heikkinen* and *Taylor* is a combination of known methods[steps?]...” As stated above, almost all inventions are combinations of known elements or steps. The examiner further states “each element combined would have performed the same function as it did separately” but the result of the combination is completely new and not suggested by the prior art. The examiner yet further states “one of ordinary skill in the art would have recognized that the results of the combination were predictable.” Where is the evidence within the prior art for the recognition of what would be the result of the combination when the combination itself is not even suggested?

In conclusion the examiner’s reasoning is basically – there is nothing preventing someone from rearranging elements from the prior art to create the claimed invention. **This reasoning is not supported by *KSR International Co. v. Teleflex Inc., et al.* or PTO policy based on the case.** As set forth in the internal memo to Technology Center Directors, dated May 3, 2006, Margaret Focarino, Deputy Commissioner of Operations, Subject: Supreme Court decision on *KSR Int’l. Co., v. Teleflex, Inc.*, page 2 states:

(4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court [in *KSR*] specifically stated:
Often, it will be necessary ... to look to interrelated teachings of

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multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, **it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.** [Emphasis added.]

Until the MPEP sets forth specific modifications to the requirements for an examiner's prima facie case of obviousness, it seems this statement must be the governing standard, and the examiner has failed to meet it, because the examiner has failed to make any arguments directed to the reasons for combining the elements from the prior art, so as to make obvious applicants claimed invention.


Because the examiner has failed to make a prima facie case of obviousness the claims should be allowed.

Applicant believes that no new matter has been added by this amendment.

Applicant submits that the claims, as amended, are in condition for allowance.

Favorable action thereon is respectfully solicited.

Respectfully submitted,



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